

AMENDMENT

U.S. Appln No. 09/011,160

43. (New) A method of filtering ferromagnetic material from a fluid in which said material is present comprising passing said material through the device of claim <sup>34</sup>37.
44. (New) A method of assembling the device of claim <sup>34</sup>37 comprising fixing said first and second plates to said magnet.

**REMARKS**

Reconsideration of the Office Action of May 15, 2002 is respectfully requested.

Accompanying this Amendment is a two month extension of time with the requisite small entity fee.

Applicant would like to thank the Examiner for the courtesies extended to Applicant's representative in discussing the present case by telephone. Applicant also acknowledges receipt of the Examiner's Interview Summary Record describing the claims to be considered and noting that a phone call will be placed with the Applicant's representative in the event that there is any reason the case is not deemed in immediate condition for allowance.

In the Office Action, there is noted that the reference citation "FR 114 135" was believed to be in error. The Examiner is correct in this regard, and the correct reference number "FR 1 114 135" (which corresponds to the reference citation in the Int'l Search Report) has been inserted in the present specification amendment.

In the present Amendment, new claims 15-44 have been presented in place of all earlier pending claims. In an effort to avoid any confusion, the new claim numbering has been started at 15 in view of the two earlier claim sets 1-14 and 1-11 having been pending in the application representing the national stage of PCT/GB96/01773.

The Office Action includes a drawing objection under 37 C.F.R. § 1.83(a) on the indicated basis of the two distribution plate feature not being illustrated in the drawings. A review of the present claim set will reveal that the two distribution plate feature has been removed (without prejudice and noting the open ended use of “comprising” in the claims) so as to render non-applicable the drawing objection.

The replacement claim set is also free of any objection relative to the objection raised in paragraph 4 of the Examiner’s Office Action concerning the terminology of former claim 10. Similarly, the rejections raised under 35 U.S.C. § 112, second paragraph, concerning claims 10 and 11 are also respectfully submitted to be non-applicable relative to the amended claim set.

The replacement claim set is also free of any improper multiple dependent claims so as to render the objection under 37 C.F.R. § 1.75(c) non-applicable.

In the Office Action, former claims 1 and 4 were rejected under 35 U.S.C. § 102(e) or (a) based on US Patent No. 5,389,252 to Morricks.

The remaining treated claims (2 and 10) were noted in the Office Action as being considered to contain allowable subject matter. In the present amendment, new independent claim 35 represents claim 2 rewritten in independent fashion (note the reference numbers were removed as being extraneous and a bridging “wherein” was utilized).

With reference to sections 7 and 8 of the Office Action, it is respectfully submitted that the subject matter defined by amended claim 1 filed herewith patentably distinguishes over the prior art and in particular over the noted Morricks reference.

A review of Morricks reveals that it only features a single metal plate having a plurality of recesses about an outer perimeter of the plate to form radially extending magnetic pole pieces.

Thus, there can be no alignment of the recesses and pole pieces on the plate 26 with recesses and pole pieces on a second plate, because the second plate is absent from Morrick.

There is indicated in section 8 of the Office Action that the Examiner considers the inlet cover plate 4 to constitute the second of the pair of claimed metal plates. However, it is respectfully submitted that cover plate cannot be said to represent the claimed second plate.

Firstly, the plate 4 in Morrick does not have a plurality of recesses about an outer perimeter of the plate to form radially extending magnetic pole pieces. Instead, the only features which could be considered to be recesses are the oil filter inlet holes 10 which are clearly positioned well within the perimeter of the plate 4. As a result, the plate 4 is not provided with radially extending pole pieces, which is supported by the fact that the outer periphery of the plate 4 is circular and continuous, without any undulations formed by recesses or the like.

Secondly, it is clear from Fig. 3 of Morrick, that the plate 4, in which the inlet holes 10 are provided and which was said to constitute the claimed plate/magnet/plate relationship, is spaced quite a distance from the lower face of the annular magnet 24 (even following compression of the seal). This spacing is not surprising in that the cover plate 4 is designed to form one end of the conventional cylindrical spin on oil filter and is not designed for use with the plate designed to attract particles for attachment thereto.

As a consequence, Morrick does not satisfy the requirement of having pole pieces on first and second plates, with corresponding pole pieces defining regions to which ferromagnetic material is attracted and retained. Indeed, the teaching of Morrick is that it is the disc 26 which collects the magnetisable particles (see column 1, lines 62-63 and column 3, lines 40-41) and there is no suggestion in Morrick that the inlet cover plate 4 is involved in trapping magnetisable particles (see column 3, lines 35-36). Indeed, and as indicated in column 3, lines 20 to 38, the

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unfiltered fluid must pass the particle-collecting disc 26 and permanent magnet 24 before entering the oil filter inlet holes. In other words the intention is to remove as many of the magnetisable particles as possible before the fluid enters the filter.

Reference is also made to the International Searchers categorization of Morrick as a category "A" or merely technical background reference relative to the then pending claims.

In addition to new independent claim 15, there is also presented new independent apparatus claims 30 and 37, which are also respectfully submitted to patentably distinguish over Morrick. Further included are process claims 33 and 34 which are respectfully submitted to patentably distinguish over the prior art as well.

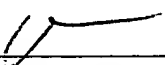
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It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present Application is in condition for allowance. Thus, prompt and favorable consideration of this Amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned.

If any additional fees are due in connection with the filing of this response, please charge such fees to Deposit Account No. 02-4300.

Respectfully submitted,  
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